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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/576,045	04/25/2007	Zhi-Jie Ni	PP020540.0003	9706

27476 7590 02/19/2009
NOVARTIS VACCINES AND DIAGNOSTICS INC.
INTELLECTUAL PROPERTY R338
P.O. BOX 8097
Emeryville, CA 94662-8097

EXAMINER

LOEWY, SUN JAE Y

ART UNIT	PAPER NUMBER
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1626

MAIL DATE	DELIVERY MODE
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02/19/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/576,045

Applicant(s)

NI ET AL.

Examiner

SUN JAE Y. LOEWE

Art Unit

1626

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 November 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-104 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 60, 65, 84, 87 and 90 is/are rejected.
- 7) ☒ Claim(s) 66, 85, 86, 88 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB-08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

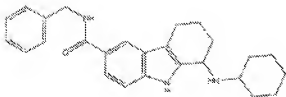
DETAILED ACTION

1. Claims 1-104 are pending in the instant application.

Election/Restrictions

2. Applicant's election with traverse of Group II and species of Example 5 (structure below) is acknowledged. The traversal is on the ground that there is no burden in examining Groups I and II jointly. The argument has been considered, however, it is not found to be persuasive. The instant application is a national stage entry of PCT/US04/34169 therefore burden is not a consideration in determining the propriety of a restriction requirement.

The restriction requirement between groups I and II is still deemed to be proper and is hereby made FINAL.



3. Pursuant MPEP 1893.03

“(Excerpts)”

Once the national stage application has been taken up by the examiner, prosecution proceeds in the same manner as for a domestic application with the exceptions that:

(A) the international filing date > (or, if appropriate, the priority date) < is the date to keep in mind when searching the prior art; and

(B) unity of invention proceeds as under 37 CFR 1.475.

.....

¶ 18.20 National Stage Election of Species in 35 U.S.C.

371 Applications

This application contains claims directed to more than one species of the generic invention. These species are deemed to lack unity of invention because they are not so linked as to form a single general inventive concept under PCT Rule 13.1.

The species are as follows:

[1]

Applicant is required, in reply to this action, to elect a single species to which the claims shall be restricted if no generic claim is finally held to be allowable. The reply must also identify the claims readable on the elected species, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered non-responsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a). ”

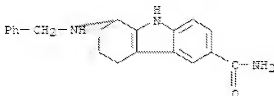
the search and examination detailed in this office action was performed following the guidelines provided by MPEP 803.02

“(Excerpts)”

Markush-type claim will be examined fully with respect to the elected species and further to the extent necessary to determine patentability. If the Markush-type claim is not allowable **, the provisional election will be given effect and examination will be limited to the Markush-type claim and claims to the elected species, with claims drawn to species patentably distinct from the elected species held withdrawn from further consideration.

If on examination the elected species is found to be anticipated or rendered obvious by prior art, the Markush-type claim and claims to the elected species shall be rejected, and claims to the nonelected species would be held withdrawn from further consideration.”

The elected species appeared be allowable. However, the non-elected species of



is obvious over the prior art. Thus, the provisional election was given effect and non-elected species were withdrawn from further consideration.

4. Claims 1-59, 61-64, 67-83, 89 and 91-104 withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected subject matter. Applicant timely traversed the election of species requirement in the response dated November 25, 2008.

Claim Objections

5. Claims 60, 65, 66, 84-88 and 90 objected to for containing non-elected subject matter. The non-elected subject matter consists of compounds of Formula I/II that are not the elected species. Applicant will be entitled to rejoinder of non-elected species upon allowability of the generic claims.

Claim Rejections - 35 USC § 103

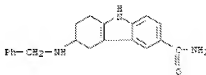
The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
 2. Ascertaining the differences between the prior art and the claims at issue.
 3. Resolving the level of ordinary skill in the pertinent art.
 4. Considering objective evidence present in the application indicating obviousness or nonobviousness.
6. Claims 60, 65, 84, 87 and 90 rejected under 35 U.S.C. 103(a) as being obvious over King et al. (caplus an 1993:212888).

Determination of the scope and contents of prior art.



The reference teaches the compound

Ascertaining the differences between prior art and instant claims.

The prior art compound is a positional isomer of the non-elected species shown above, Section 3.

Resolving the level of ordinary skill in the pertinent art – Prima Facie Case of Obviousness.

Position isomers are generally of sufficiently close structural similarity that there is a presumed expectation that such compound possess similar properties. MPEP §2144.09.

One of ordinary skill would be motivated to make the modification required to arrive at the instant invention with reasonable expectation of obtaining an additional compound for the same utility.

Thus, the instantly elected species is *prima facie* obvious over the prior art.

Conclusion

7. No claims allowed.
8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sun Jae Y. Loewe whose telephone number is (571) 272-9074. The examiner can normally be reached on M-F 7:30-5:00 Est.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph McKane can be reached on (571)272-0699. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Sun Jae Y. Loewe/
2-11-2009

/Golam M. M. Shameem/
Primary Examiner, Art Unit 1626